UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,382	09/30/2003	Corinne Bortolin	16222U-016700US	9159

66945 7590 05/16/2011

KILPATRICK TOWNSEND & STOCKTON LLP/VISA
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

EXAMINER	
LASTRA, DANIEL	
ART UNIT	PAPER NUMBER
3688	
MAIL DATE	DELIVERY MODE
05/16/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/676,382	BORTOLIN ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-32,34-37 and 39-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-32, 34-37 and 39-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 21-32, 34-37 and 39-52 have been examined. Application 10/676,382 (SYSTEM AND APPARATUS FOR LINKING MULTIPLE REWARDS PROGRAMS TO PROMOTE THE PURCHASE OF SPECIFIC PRODUCT MIXES) has a filing date 09/30/2003.

Response to Amendment

2. In response to Non Final Rejection filed 11/09/10, the Applicant filed an Amendment on 03/07/11, which amended claims 21, 32 and added new claims 49-52 .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-23, 25-26, 28-29, 32, 35-36, 39, 41-44 and 46-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Fernandez (US 2001/0016827).

Claims 21, 32 Fowler teaches:

A method comprising: receiving information at a host server computer about a first pre-existing reward program created by a first merchant, wherein the first pre-

existing offline reward program provides for a first reward when a first product is purchased at the first merchant (see paragraphs 19-20);

receiving information at the host server computer about a second pre- existing reward program created by a second merchant, wherein the second pre-existing reward program provides a second reward when a second product is purchased at the second merchant (see paragraph 31); and

using the host server computer, providing for a combination reward program that is linked to the first pre-existing reward program and the second pre-existence reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, wherein the combination reward program is provided by a reward sponsor, wherein the first merchant is different than the second merchant (see paragraph 26-31), and wherein the combination reward is *an award in addition to the first award and the second award and is* given to a consumer *in addition to the first award and the second award* if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location (See paragraphs 26-31, 83, 103 "multiple awards programs may be operated based on a single qualifying transaction"; paragraph 80 "multiple benefits from a number of marketing programs may be awarded");

wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer (see paragraph 83-85, 90 "a

point of transaction may also be a PDA" or the use of a smartcard which are updated with current loyalty information such a current points, lifetime cumulative points").

Fowler does not teach and wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer. However, Fernandez teaches an offline loyalty program where all loyalty transaction of debiting or crediting a smart card are performed at point of sale terminal (i.e. offline) without the need to contact a host server (see paragraph 23-24, 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that because Fowler smart cards may host a transaction processing module previously hosted by a host server (see paragraph 58) and because Fowler accommodates instances when communication with host system is not possible by performing a loyalty transaction at the point of sale terminal (see paragraph 70) that Fowler would modify his invention to download loyalty parameters to POS terminals, as taught by Fernandez in order to add the feature of not needing to contact a host server (i.e. offline) in order to perform a loyalty transaction of crediting or debiting a smart card.

Claim 22, Fowler teaches:

providing the combination reward to the consumer at the first merchant at the first location, wherein the combination reward can be used at the second merchant at the second location (see paragraph 105).

Claim 23, Fowler teaches:

wherein the portable consumer device is a smart card and wherein the combination reward is in the form of a coupon (see paragraph 40, 83).

Claim 25, Fowler teaches:

wherein the combination reward program is created by the reward sponsor that is affiliated with the first merchant and the second merchant (see paragraph 22).

Claim 26, Fowler teaches:

wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased (see paragraph 19).

Claim 28, Fowler teaches:

wherein the one or more digital computers comprises a server computer, and wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant (see paragraph 28).

Claim 29, Fowler teaches:

wherein the first product and the second product are made by the same manufacturer (See paragraph 82 "brand").

Claim 35, Fowler teaches:

wherein the combination reward program is created by the host organization that is affiliated with the first merchant and the second merchant (see paragraph 22).

Claim 36, Fowler teaches:

wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased (see paragraph 19).

Claim 39, Fowler teaches:

wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant (see paragraph 53-54).

Claims 41-42, Fowler teaches:

wherein the combination reward is of greater value than the first reward or the second reward (See paragraph 75).

Claim 43, Fowler teaches:

wherein the host server computer is hosted by a credit card processing company (see paragraph 19 "institution").

Claim 44 Fowler teaches:'

wherein the reward sponsor is a credit, debit, or smart card issuer (see paragraph 65 "merchant is an institution").

Claim 46 Fowler teaches:

wherein the portable consumer device is a mobile phone with a microprocessor that communicates with a card acceptance device (See paragraph 68).

Claim 47 Fowler teaches:

wherein each portable consumer device is associated with a different consumer (See paragraph 17).

Claim 48 Fowler teaches:

wherein each portable consumer device is embossed with consumer identification information (see paragraph 17).

Claim 49, Fowler teaches:

customizing future reward redemption and accumulation based on the product preference of the consumer (see paragraph 82, 86 "providing added benefit based upon customer behavior or preference and custom coupon such as discounts on present or future transactions").

Claim 50, Fowler teaches:

wherein the combination reward is provided to the consumer via a reduction in the price of the second product (see paragraph 82, 86 "providing added benefit based upon customer behavior or preference and custom coupon such as discounts").

Claim 51, Fowler teaches:

customizing future reward redemption and accumulation based on the product preference of the consumer (see paragraph 82, 86 "providing added benefit based upon customer behavior or preference and custom coupon such as discounts on present or future transactions").

Claim 52, Fowler teaches:

wherein the combination reward is provided to the consumer via a reduction in the price of the second product (see paragraph 82, 86 "providing added benefit based

upon customer behavior or preference and custom coupon such as discounts on present or future transactions").

4. Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Ryan (US 2005/0055272).

Claim 24, Fowler does not teach:

wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward. However, Ryan teaches that it is old and well known in the promotion art to extend the expiration date of a reward (i.e. cash value coupon) when said reward is offered in combination with another reward (i.e. joint a private club as a reward) (see paragraph 52). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer coupon rewards with an extension of time, when said coupon rewards are offered with a combination of another product, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

5. Claims 27, 34, 37 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Nerger Monika, Evening the odds: CRM systems are driving sophisticated loyalty programs at Las Vegas Casinos - and not just for the high rollers, March 1, 2002.

Claims 27, 34 and 37, Fowler does not teach:

wherein the combination reward gives the consumer access to a special program earlier than another consumer that has not purchased the first product and the second product. However, Evening the odds teaches that it is old and well known in the promotion art to have loyalty programs where a customer receives preferential treatment, such as access to transportation earlier in time than other customers (i.e. not need to wait in line) when said customer earned enough loyalty points to achieve a specific tier level (see page 1). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would offer a customer that has purchased two products access to special programs earlier than other customers that had not purchased said two products and had not earned enough loyalty points, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 45, Fowler does not teach:

wherein the special program is a reward program provided by a credit card processing company. However, Evening the odds teaches that it is old and well known in the promotion art to have loyalty programs (i.e. payment card or loyalty card) where a customer receives preferential treatment, such as access to transportation earlier in time than other customers (i.e. not need to wait in line) when said earned enough loyalty points to achieve a specific tier level (see page 1). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to

know that Fowler would offer a customer that has purchased two products access to special programs earlier than other customers that had not purchased said two products and had not earned enough loyalty points, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

6. Claims 30-31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (US 2002/0026348) in view of Postrel (US 6,594,640).

Claims 30-31, Fowler teaches:

wherein the portable consumer device is a smartcard (see paragraph 83) but does not expressly teach that conforms to ISO standard 7816, wherein the smartcard includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards. However, Postrel teaches that it is old and well known in the promotion art to stored rewards from a loyalty program in smart cards (see col 9, lines 55-65) and Official Notice is taken that it is old and well known to have smart cards that conforms to ISO standard 7816. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Fowler would store rewards on smart cards, as taught by Postrel that conforms to ISO standard 7816, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Applicant's arguments filed 03/07/11 have been fully considered but they are not persuasive. The Applicant argues that the prior arts do not teach "wherein the combination reward is *an award in addition to the first award and the second award and is* given to a consumer *in addition to the first award and the second award* if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location". The Examiner answers that Fowler teaches in paragraphs 26-31, 83, 103 "multiple awards programs may be operated based on a single qualifying transaction"; paragraph 80 "multiple benefits from a number of marketing programs may be awarded". Therefore, contrary to Applicant's argument, Fowler teaches multiple awards which can be a third award in addition of a first and a second award.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Primary Examiner, Art Unit 3688
May 13, 2011